

REMARKS

I. Notice of Non-Compliant Amendment

A Notice of Non-Compliant Amendment was mailed on January 14, 2010, in response to the Request for Reconsideration filed on September 29, 2009. In the Notice, checkboxes 4A and 4C are marked, indicating that "[a] complete listing of all the claims is not present" and "[e]ach claim has not been provided with the proper status identifier." However, no claims were amended in the Request for Reconsideration and, therefore, a complete listing of claims, with status identifiers, was not required in the Request for Reconsideration. See M.P.E.P. § 714.02 and 37 C.F.R. § 1.111 (b).

While Applicant does not agree with the requirements set forth in the Notice, in order to advance prosecution, Applicant hereby submits this paper which includes a complete listing of the claims in the application. In addition, Applicant again presents the remarks set forth in the Request for Reconsideration of September 29th.

Applicant respectfully requests that the Examiner consider and enter this Response and the Request for Reconsideration filed on September 29, 2009.

II. Status of Claims

Claims 1-37 pending, with claims 7-19 and 33-37 under current examination, and claims 1-6 and 20-32 withdrawn from consideration. In the Office Action¹, the Examiner rejected claims 7-19 and 33-37² under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 7,133,901 ("Dalby").

II. Rejection under 35 U.S.C. § 102(e)

Applicant respectfully traverses the rejection of claims 7-19 and 33-37 under 35 U.S.C. § 102(e) as being anticipated by Dalby for at least the following reasons.

In order to properly anticipate Applicant's claims under 35 U.S.C. § 102, each and every element of the claim in issue must be "either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989)." See M.P.E.P. § 2131.

Dalby does not disclose each and every element of Applicant's claims as recited in independent claim 7. For example, Dalby does not disclose Applicant's claimed:

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

² Claim 37 is not listed in the statement of rejection on page 4 of the Office Action, but is discussed on page 8 of the Office Action. Applicant therefore responds to the rejection of claims 7-19 and 33-37 in section II of this paper.

"receiving, using a processor, a message from a user; [and]

receiving, based on the message, a characteristic identifying a first subgroup of selected participants in an enterprise, wherein receiving the characteristic comprises extracting the characteristic from the message based on at least one of a keyword search, natural language parsing and application of a rule-based expert system, the characteristic hard-coded into a set of machine-readable instructions for segmenting communication recipients,"

as recited in independent claim 7.

Instead, Dalby discloses a "system[] for transmitting electronic announcements or messages to selected users based upon their associated attributes," wherein the system comprises a message module and an interface module. Dalby, col. 2, lines 24-27. The interface module generates a template that "includes one or more fields within which various announcement attributes and data can be defined ... [and] generate[s] [an] electronic announcement or message from the data entered ... into the template.... [T]he message module can transmit the electronic announcement or message to one or more recipients that have the one or more attribute values selected." Id., col. 2, lines 29-40. Further, "[i]n communication with interface module 322 is message module 324 [which] is configured to receive data and information from interface module 322 to enable an administrator or other delegated user to create an announcement to be displayed persistently to a recipient or group of recipients upon ... associated personalized web page(s)." Id., col. 12, lines 22-28.

That is, Dalby discloses sending electronic announcements or messages to users that are selected based on attributes associated with the users. Dalby does not disclose, for example, "receiving, using a processor, a message from a user; [and]

receiving, based on the message, a characteristic identifying a first subgroup of selected participants in an enterprise," as recited in claim 7. Dalby also does not disclose that "receiving the characteristic comprises extracting the characteristic from the message based on at least one of a keyword search, natural language parsing and application of a rule-based expert system, the characteristic hard-coded into a set of machine-readable instructions for segmenting communication recipients," as also recited in claim 7. Indeed, Dalby does not disclose receiving or extracting any information from a message.

In response to the arguments set forth in the Amendment after Final filed April 6, 2009, the Examiner alleged that "Dalby teaches *receiving, based on the message* (notifying message), *a characteristic* (criteria attribute, recipient attributes) *identifying a first subgroup of selected participants.*" Office Action at 3 (emphasis in original). Applicant respectfully disagrees. Both the target criteria attribute and recipient attributes disclosed by Dalby are used to determine recipients to whom a message should be sent. For example, the "target criteria attribute defines the criteria to be searched by the information system to identify the particular recipient or group of recipients to receive the announcement." Dalby, col. 4, lines 9-12. Also, a target criteria selection field in a template "can be filled with recipient attributes" and "the message module can transmit the electronic announcement or message to one more recipients that have the one or more attribute values selected in the targeting criteria selection field." Id., col. 2, lines 33-34 and 37-41. Neither the target criteria attribute nor the recipient attributes disclosed by Dalby are received or extracted from a message.

For at least these reasons, Dalby does not disclose each and every element of Applicant's claimed invention as recited in independent claim 7. Independent claim 7 is therefore not anticipated by Dalby. Independent claim 33, while differing in scope, recites similar limitations as claim 7, and is also not anticipated by Dalby, at least for reasons similar to those presented regarding claim 7. Claims 8-19 and 34-37, which depend from claim 7 or claim 33, are also not anticipated by Dalby. Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 7-19 and 33-37.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests the Examiner's reconsideration of the application, and the timely allowance of the pending claims.

The Examiner is invited to contact the undersigned with any questions or comments.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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